

## **REMARKS:**

Claims 1-33 are currently pending in the application. Claims 2-5, 9, 13-16, 20, 22-25, 29, 32, and 33 have been withdrawn from further consideration. Claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 7,003,474 B2 to Derek Lidow ("*Lidow*"). Claim 10 stands rejected under 35 U.S.C. § 103(a) over *Lidow*. Claim 31 stands rejected under 35 U.S.C. § 103(a) over *Lidow* in view of U.S. Patent No. 6,567,783 to Notani et al. ("*Notani*").

Although the Applicants believe claims 1-33 are directed to patentable subject matter, and in condition for allowance without amendment. The Applicants have amended independent claims 1, 12, 21, 30, and 31 in order to correct certain typographical errors. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed claims 1-33. No new matter has been added.

The Applicants respectfully submit that upon the allowance of a generic claim (i.e. one or more of independent claims 1, 12, 21, and 30-33) the Applicants are entitled to consideration of claims to additional species (i.e. species 1b through 1f or any additional species added after the election of species) which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141.

## **REJECTION UNDER 35 U.S.C. § 102(e):**

Claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30 stand rejected under 35 U.S.C. § 102(e) over *Lidow*.

Although the Applicants believe claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30 are directed to patentable subject matter without amendment, the Applicants have amended

independent claims 1, 12, 21, 30, and 31 in order to correct certain typographical errors. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(e), as set forth in the Office Action.

The Applicants respectfully submit that *Lidow* fails to disclose each and every limitation recited by claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30. The Applicants further submit that claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30 patentably distinguish over *Lidow*. Thus, the Applicants respectfully traverse the Examiner's rejection of claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30 under 35 U.S.C. § 102(e) over *Lidow*.

### ***Lidow* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

For example, with respect to independent claim 1, this claim recites:

***A system for managing a value chain***, comprising:  
***a planning application*** operable to ***receive planning data from a plurality of entities included in a value chain and to automatically generate a plan according to the planning data***, at least two of the entities not directly communicating planning data to one another; and  
***a manager application*** operable to:  
    receive the plan and ***automatically identify one or more exceptions*** in the plan;  
    ***communicate planning data relating to the exceptions*** to one or more of the entities;  
    ***receive instructions from one or more of the entities*** regarding how the exceptions are to be resolved; and  
    ***automatically modify the planning data in response to the instructions***. (Emphasis Added).

Independent claims 12, 21, 30, and 31 recite similar limitations. *Lidow* fails to disclose each and every limitation of independent claims 1, 12, 21, 30, and 31.

The Applicants respectfully submit that *Lidow* has nothing to do with independent claim 1 limitations regarding a ***“system for managing a value chain”*** and in particular *Lidow* has nothing to do with independent claim 1 limitations regarding a ***“planning application*** operable to ***receive planning data from a plurality of entities included in a***

**value chain**". In particular, the Examiner equates the "**planning application** operable to **receive planning data**" recited in independent claim 1 with "**receiving forecasts**" disclosed in *Lidow*. (27 March 2006 Office Action, Page 2). (Emphasis Added). However, "**receiving forecasts**" **disclosed in Lidow** merely allows the server to receive forecasts from the customers for the orders that the customers desire, and **does not include, involve, or even relate to receiving planning data, as recited in independent claim 1**. (Column 3, Lines 29-33). In contrast, the "**planning application** operable to **receive planning data**" recited in independent claim 1 receives "**planning data from a plurality of entities included in a value chain**" and the "**planning data**" is not limited to merely forecasts from the customer. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Lidow* and independent claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent claim 1 from *Lidow*.

The Applicants further respectfully submit that, as discussed above, *Lidow* has nothing to do with independent claim 1 limitations regarding a "**planning application** operable to **receive planning data from a plurality of entities included in a value chain**" and in addition *Lidow* has nothing to do with independent claim 1 limitations regarding the ability to "**automatically generate a plan according to the planning data**, at least two of the entities not directly communicating planning data to one another". In particular, the Examiner equates "**generat[ing] a plan according to the planning data**" recited in independent claim 1 with "**planners** for generating plans" disclosed in *Lidow*. (27 March 2006 Office Action, Page 4). (Emphasis Added). However, the "**planners**" **disclosed in Lidow** are merely "employees of the operator supply chain server" and **have nothing to do with "automatically generat[ing] a plan according to the planning data"**, as recited in independent claim 1. (Column 8, Lines 11-27). In contrast, "**generat[ing] a plan according to the planning data**" recited in independent claim 1 is **automatically generated based on the planning data received from a plurality of entities included in the value chain**. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Lidow* and independent claim 1 cannot be made. The

Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent claim 1 from *Lidow*.

The Applicants still further respectfully submit that *Lidow* has nothing to do with independent claim 1 limitations regarding a “***manager application***” and in particular *Lidow* has nothing to do with independent claim 1 limitations regarding a “***manager application*** operable to receive the [automatically generated] plan and ***automatically identify one or more exceptions*** in the [automatically generated] plan and ***communicate planning data relating to the exceptions*** to one or more of the entities [in the value chain]”. Rather, *Lidow* discloses an order management module which merely receives a customer demand. (Column 7, Line 60 through Column 8, Line 5). The order management module in *Lidow* merely verifies that every part number exists in the server system and fails to disclose, teach or even hint at ***receiving the automatically generated plan and automatically identifying one or more exceptions in the automatically generated plan***, as recited in Applicants claims. (Abstract). Thus, *Lidow* cannot provide for a “***manager application*** operable to receive the [automatically generated] plan and ***automatically identify one or more exceptions*** in the [automatically generated] plan and ***communicate planning data relating to the exceptions*** to one or more of the entities [in the value chain]”, since *Lidow* does not even teach, suggest, or hint at ***receiving the automatically generated plan and automatically identifying one or more exceptions in the automatically generated plan***.

The Applicants yet further submit that *Lidow* has nothing to do with independent claim 1 limitations regarding a “***manager application*** operable to ***receive instructions from one or more of the entities [in the value chain]*** regarding how the exceptions are to be resolved and ***automatically modify the planning data in response to the instructions***”. In particular, the Examiner equates “***receiv[ing] instructions from one or more of the entities [in the value chain]***” recited in independent claim 1 with ***receiving a customer forecast*** disclosed in *Lidow*. (27 March 2006 Office Action, Pages 3-4). (Emphasis Added). However, ***receiving a customer forecast disclosed in Lidow*** merely allows the server to receive forecasts from the customers for the

orders that the customers desire and ***has nothing to do with “receiv[ing] instructions from one or more of the entities [in the value chain]”***, as recited in independent claim 1. (Column 3, Lines 29-33 and Column 15, Lines 46-65). In contrast, ***“receiv[ing] instructions from one or more of the entities [in the value chain]”*** recited in independent claim 1 are ***instructions on how the exceptions are to be resolved*** and are further provided for ***“automatically modify[ing] the planning data in response to the instructions”***. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Lidow* and independent claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish independent claim 1 from *Lidow*.

The Applicants respectfully submit that the allegation in the present Office Action that *Lidow* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Lidow* is considered to anticipate all of the limitations claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added). With respect to the subject Application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of the Applicants claimed invention is identically shown in *Lidow*. For example, the Examiner asserts that the ***“planning application operable to receive planning data”***, in independent claim 1 is somehow equivalent with ***“receiving forecasts”*** in *Lidow*. (27 March 2006 Office Action, Page 2). ***The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion.*** In another example, the Examiner asserts that ***“generat[ing] a plan according to the planning data”***, in independent claim 1 is somehow equivalent with ***“planners for generating plans”*** in *Lidow*. (27 March 2006 Office Action, Page 4). ***The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion.*** In still another example, the Examiner asserts that ***“receiv[ing] instructions from one or more of the entities [in the value chain]”***, in independent claim 1 is

somehow equivalent with ***receiving a customer forecast*** disclosed in *Lidow*. (27 March 2006 Office Action, Pages 3-4). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. The Applicants respectfully point out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submit that ***the Office Action has failed to establish a prima facie case of anticipation in claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30 under 35 U.S.C. § 102 with respect to Lidow because Lidow fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claims.***

#### **The Applicants Claims are Patentable over *Lidow***

With respect to independent claims 12, 21, 30, and 31 these claims includes limitations similar to those discussed above in connection with independent claim 1. Thus, independent claims 12, 21, 30, and 31 are considered patentably distinguishable over *Lidow* for at least the reasons discussed above in connection with independent claim 1.

Furthermore, with respect to dependent claims 6-8, 11, 17-19, and 26-28: claims 6-8 and 11 depend from independent claim 1; dependent claims 17-19 depend from independent claim 12; and dependent claims 26-28 depend from independent claim 21 are also considered patentably distinguishable over *Lidow*. Thus, dependent claims 6-8, 11, 17-19, and 26-28 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicants respectfully submit that independent claims 1, 12, 21, 30, and 31 and dependent claims 6-8, 11, 17-19, and 26-28 are not anticipated by *Lidow*. The Applicants further respectfully submit that independent claims 1, 12, 21, 30, and 31 and dependent claims 6-8, 11, 17-19, and 26-28 are in condition for allowance. Thus, the Applicants respectfully requests that the rejection

of claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30 under 35 U.S.C. § 102(e) be reconsidered and that claims 1, 6-8, 11-12, 17-19, 21, 26-28, and 30 be allowed.

**THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.



2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

### **REJECTION UNDER 35 U.S.C. § 103(a):**

Claim 10 stands rejected under 35 U.S.C. § 103(a) over *Lidow*. Claim 31 stands rejected under 35 U.S.C. § 103(a) over *Lidow* in view of *Notani*.

Although the Applicants believe claim 31 is directed to patentable subject matter without amendment, the Applicant has amended independent claim 31 to correct certain typographical errors. By making this amendment, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that *Lidow* or the Examiner's purported Official Notice, either individually or in combination, fails to disclose, teach, or suggest each and every element of claim 10. The Applicants further respectfully submit that *Lidow*, or *Notani*, either individually or in combination, fails to disclose, teach, or suggest each and every element of claim 31. In addition, the Applicants respectfully submit that, as explained below, *Notani* is disqualified as prior art, in accordance with 35 U.S.C. § 103(c) and MPEP 706.02(I)(1). Thus, the Applicants respectfully traverse the Examiner's obvious rejection of claims 10 and 31 under 35 U.S.C. § 103(a) over the proposed combination of *Lidow*, *Notani*, and the Examiner's purported Official Notice, either individually or in combination.

### **The Proposed *Lidow-Official-Notice* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claim 10**

For example, with respect to dependent claim 10, this claim recites:

The system of Claim 1, further comprising ***an electronic marketplace that supports the planning application and the manager application.*** (Emphasis Added).

*Lidow* or the Examiner's purported Official Notice, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claim 10.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Lidow* fails to disclose the emphasized limitations in dependent claim 10. Specifically, the Examiner acknowledges that “*Lidow* fails to explicitly disclose an electronic marketplace that supports the planning application and the manager application.” (27 March 2006 Office Action, Page 4). However, it appears that the Examiner is asserting Official Notice over the acknowledged shortcomings in *Lidow*. The Applicants respectfully traverse the Examiner’s purported Official Notice.

The Applicants further respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Lidow* and the Examiner’s purported Official Notice, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Lidow* and the Examiner’s purported Official Notice as proposed. The Office Action merely states that “it would have been obvious to a person of ordinary skill in the art **to have modified the disclosures of Lidow to incorporate an electronic marketplace as a hub between the entities**”. (27 March 2006 Office Action, Page 4). (Emphasis Added). The Applicants respectfully disagree.

The Applicants still further respectfully submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Lidow* or the Examiner’s purported Official Notice, either individually or in combination. The Examiner appears to be asserting that a person of ordinary skill in the art would have been motivated to combine the references as proposed “in order **to perform transaction[s] between them**.” (27 March 2006 Office Action, Page 4). (Emphasis Added). The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does “**perform[ing] transaction[s] between them**” directly relate to “**an electronic marketplace as a hub between the entities**” and to what extent does the Examiner purport that “in order **to perform transaction[s] between them**” applies to “**an electronic marketplace that supports the planning application and the manager application**” or even applies to the subject Application. *The*

***Applicants respectfully request the Examiner to point to the portions of Lidow or the Examiner's purported Official Notice which contain the teaching, suggestion, or motivation to combine these references for the for the Examiner's stated purported advantage.*** In particular, the Applicants respectfully request the Examiner to point to the portions of *Lidow* or the Examiner's purported Official Notice which expressly states that the ***"incorporate[tion of] an electronic marketplace as a hub between the entities in order to perform transaction[s] between them"*** accounts for ***"an electronic marketplace that supports the planning application and the manager application"***, as recited in Applicants claim. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention***, and that ***any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of Lidow or the Examiner's purported Official Notice to render obvious the Applicants claimed invention.*** The Examiner's conclusory statements that "it would have been obvious to a person of ordinary skill in the art ***to have modified the disclosures of Lidow to incorporate an electronic marketplace as a hub between the entities***" or that a person of ordinary skill in the art would have been motivated to combine the references as proposed ***"in order to perform transaction[s] between them"***, ***does not adequately address the issue of motivation to combine.*** (27 March 2006 Office Action, Page 4). (Emphasis Added). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* (Emphasis Added). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the***

*teachings of Lidow or the Examiner's purported Official Notice*, either individually or in combination.

**The Proposed *Lidow-Notani* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Independent Claim 31**

The Applicants respectfully submit that *Lidow* or *Notani*, either individually or in combination, fails to disclose, teach, or suggest each and every element of amended independent claim 31. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of amended independent claim 31 under 35 U.S.C. § 103(a) over the proposed combination of *Lidow* and *Notani*, either individually or in combination.

For example, with respect to amended independent claim 31, this claim recites:

***A system for managing a value chain***, comprising:  
***a planning application*** operable to:

receive planning data from a plurality of entities included in a value chain, at least two of the entities not directly communicating planning data to one another;

receive set-up information from one or more of the entities, the set-up information including characteristics of the value chain; and

automatically generate a plan according to the planning data;  
and

***a manager application*** operable to:

receive the plan and automatically identify one or more exceptions in the plan;

automatically communicate a notification regarding the existence of an exception to one or more of the entities;

receive a request for information about the exception from one or more of the entities in response to the notification;

***automatically communicate planning data relating to the exception to one or more of the entities in response to receiving the request, the manager application controlling access to the planning information based on a permissibility framework;***

receive instructions from one or more of the entities regarding how the exceptions are to be resolved; and

automatically modify the planning data in response to the instructions. (Emphasis Added).

*Lidow* or *Notani*, either individually or in combination, fail to disclose, teach, or suggest each and every element of amended independent claim 31.

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Lidow* fails to disclose the emphasized limitations noted above in dependent claim 2. Specifically, ***the Examiner acknowledges that Lidow fails to disclose “the concept of controlling access to the planning information based on a permissibility framework”.*** (27 March 2006 Office Action, Page 5). However, the Examiner asserts that the cited portions of *Notani* disclose the acknowledged shortcomings in *Lidow*. The Applicants respectfully traverse the Examiner’s assertions regarding the subject matter disclosed in *Notani*.

The Applicants respectfully submit that the subject Application and the *Notani* U.S. Patent Application Publication were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same entity, i2 Technologies US, Inc. ***In accordance with 35 U.S.C. § 103(c) and MPEP 706.02(l)(1), Notani is disqualified as prior art, in the subject Application.*** Thus, the Applicants respectfully submit that amended independent claim 31 is in condition for allowance.

As mentioned above, the rejection under 35 U.S.C. §103(a) is moot in view of *Notani* being rejected as prior art. Thus, for at least the reasons set forth herein, the Applicants submit that amended independent claim 31 is not anticipated by *Notani*. The Applicants further submit that amended independent claim 31 is in condition for allowance. Thus, the Applicants respectfully request that the rejection of amended independent claim 31 under 35 U.S.C. § 103(a) be reconsidered and that amended independent claim 31 be allowed.

### **The Applicants Claims are Patentable over the Proposed *Lidow-Notani-Official-Notice* Combination**

With respect to dependent claims 10, claim 10 depends from amended independent claim 1. As mentioned above, amended independent claim 1 is considered patentably distinguishable over *Lidow*, *Notani*, and the Examiner’s Official Notice. Thus,

dependent claims 10 is considered patentably distinguishable over the proposed combination of *Lidow, Notani*, and the Examiner's Official Notice for at least the reasons of depending from an allowable claim and are therefore considered to be in condition for allowance.

For at least the reasons set forth herein, the Applicants submit that claims 10 and 31 are not rendered obvious by the proposed combination of *Lidow, Notani*, and the Examiner's Official Notice. The Applicants further submit that claims 10 and 31 are not rendered obvious by the proposed combination of *Lidow, Notani*, and the Examiner's Official Notice and are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 10 and 31 under 35 U.S.C. § 103(a) be reconsidered and that claims 10 and 31 be allowed.

#### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there ***must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and ***not based on applicant's disclosure***. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to ***suggest*** the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence



of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

6/9/06  
Date

  
James E. Walton, Registration No. 47,245  
Steven J. Laureanti, Registration No. 50,274  
Brian E. Harris, Registration No. 48,383  
Daren C. Davis, Registration No. 38,425  
Michael Alford, Registration No. 48,707  
Alan Dawson Lightfoot, Registration No. 57,756  
Law Offices of James E. Walton, P.L.L.C.  
1169 N. Burleson Blvd., Suite 107-328  
Burleson, Texas 76028  
(817) 447-9955 (voice)  
(817) 447-9954 (facsimile)  
jim@waltonpllc.com (e-mail)

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**ATTORNEYS AND AGENTS FOR APPLICANTS**